

APR 13 2005

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REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)

B04-04

In re Application of: Michael J. Sullivan et al.

Application No.: 10/797,699

Filed: March 10, 2004

For: MULTI-LAYERED CORE GOLF BALL

The owner, Acushnet Company of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending reference Application Number 10/797,810, filed on March 10, 2004, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the reference application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said reference application, "as the term of any patent granted on said reference application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending reference application." In the event that: any such patent granted on the pending reference application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 38,400

D. Michael Burns
Signature

April 13, 2005
Date

D. Michael Burns
Typed or printed name

508-979-3563
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

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Appl. No.: 10/797,810
TC/A.U.: 3711 Docket No.: B04-08
Reply to Office Action of March 23, 2005

REMARKS

In the specification, the paragraph on page 1 for **CROSS REFERENCE TO RELATED APPLICATIONS** has been amended to correct minor editorial problems and/or typographical errors. The reference to application 09/815,753 has been deleted as it was issued as a patent prior to the filing of the present application.

Claims 1-27 appear in this application for the Examiner's review and consideration.

Rejection Under Obviousness-type Double Patenting

Claims 1-27 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of co-pending Application No. 10/797,810.

A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith and included in the appendix of this response. It is believed this terminal disclaimer will overcome this provisional rejection.

Applicants respectfully request reconsideration and withdrawal thereof.


Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

No fee, except for the Terminal Disclaimer fee, is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

April 13, 2005
Date


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